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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,878	09/06/2006	Tony Whittaker	WW/3-22356/A/PCT	4510
324	7590	07/29/2009		
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				
EXAMINER				
HRUSKOCI, PETER A				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
07/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/591,878

Applicant(s)

WHITTAKER ET AL.

Examiner

/Peter A. Hruskoci/

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrow et al. 5,213,693 in view of Batty et al. 5,834,545. McGrow et al. (see col. 2 line 41 through col. 6 line 62) disclose a process of dewatering an aqueous suspension substantially as claimed. It is submitted that the cationic coagulant polymer utilized in McGrow et al. is considered patentably indistinguishable from the first flocculant. The claims differ from McGrow et al. by reciting the second flocculant is mixed with the suspension in the form of a particulate polymer. Batty et al. disclose (see col. 4 line 47 through col. 7 line 20) that it is known in the art to mix a flocculant composition including polymer particles with a suspension, to aid in dewatering the suspension. It would have been obvious to one skilled in the art to modify the process of McGrow et al. by utilizing the recited particulate polymer view of the teachings of Batty et al., to aid in flocculating and dewatering the suspension. The specific particle diameter and second flocculants utilized, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific sludge treated and results desired, absent a sufficient showing of unexpected results. With regard to claims 15-17, it is

submitted that Batty et al. as applied above, appears to teach the use of the recited coating or matrix of silicone or wax.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGrow et al. 5,213,693 in view of Batty et al. 5,834,545 as above, and further in view of Sorensen et al. 5,846,433. The claim differs from the references as applied above by reciting the first flocculant comprises particles having a specific diameter. Sorensen et al. disclose (see col. 7 line 3 through col. 8 line 17) that it is known in the art to utilize a flocculant polymer particles having the recited diameter, to aid in dewatering a suspension. It would have been obvious to one skilled in the art to modify the references as applied above by utilizing the recited particles view of the teachings of Sorensen et al., to aid in flocculating and dewatering the suspension. The specific particle diameter utilized, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific sludge treated and results desired, absent a sufficient showing of unexpected results.

Claim 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrow et al. 5,213,693 in view of Batty et al. 5,834,545 as above, and further in view of Ghafoor et al. 6,001,920. The claims differ from the references as applied above by reciting the second flocculant is introduced into the suspension in the form of slurry in a specific liquid. Ghafoor et al. disclose (see col. 1 line 16 through col. 6 line 36) that it is known in the art to utilize polyethylene glycol to aid in stabilizing a polymer coagulant utilized in flocculating sludge suspensions. It would have been obvious to one skilled in the art to modify the references as applied above, by utilizing the recited slurry in view of the teachings of Ghafoor et al., to aid in flocculating and dewatering the suspension.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11, 18, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 5-14 of copending Application No. 10/591,776. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process steps recited in the instant claims appear to be fully encompassed by the process steps recited in the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants argue that the addition of the coagulant and solution of anionic flocculant as in McGrow et al. would be contrary to the process of the present invention in which the first flocculant brings about flocculation and assists thickening and the second flocculant further dewater the thus thickened suspension. It is submitted that the addition of the coagulant or blend of cationic coagulant and cationic flocculant as in McGrow et al. would appear to bring about flocculation, assist in thickening and dewatering as in the instant invention. It is noted that the dewatering of a thickened suspension is not recited in the instant claims. It is further noted that the addition of an anionic flocculant is not excluded from the instant claims. Furthermore, applicants have not supplied sufficient factual evidence to support the above allegation.

Applicants argue that Batty is silent on the polymer i.e. the water-soluble or water swellable polymer, equating to the second flocculant having a particle size recited in claim 1. It is submitted that the polymers disclosed in col. 5 of Batty are water soluble and include particles of the recited size.

Applicants argue that Batty does not suggest any improvements by providing larger flocculant particles as recited in the instant claims, and any desire to delay the dissolution of the

flocculant polymer nor provide a system in which a suspension that has already been thickened is further dewatered in a separate step. It is submitted that applicants have not presented sufficient factual evidence of any improvements to support the above argument. Furthermore, a delay in flocculant dissolution and thickening of the suspension prior to dewatering, are not recited in the instant claims.

Applicants argue that replacing the flocculant of McGrow with the particles of Batty would bring about flocculation before thickening has taken place, and not be a two-step process. It is noted that a two-step process is not recited in the instant claims. It is further noted that instant claims 12 and 13 are drawn to a simultaneous addition of the first and second flocculants, and the use of a single composition of the flocculants, which appear to include a one-step process.

Applicants' arguments concerning Sorensen are based on the propriety of the combination of McGrow and Batty. This combination is deemed properly applied for reasons stated above.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Peter A. Hruskoci/ whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter A. Hruskoci/
Primary Examiner
Art Unit 1797

7/15/09